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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,472	08/01/2000	GERWIG MARQUARDT	60GB00128	7013

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EXAMINER
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ZEMEL, IRINA SOPJIA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/530,472	MARQUARDT, GERWIG	
	Examiner	Art Unit	
	Irina S. Zemel	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 4-6, 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/26/2000</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 9 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim 9 is withdrawn from further consideration on the merits.

### ***Claim Objections***

Claims 4-6 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can not depend on another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 4-6 have not been further treated on the merits.

Claims 1-3 and 7 are objected to because of the following informalities: The claims recites "close-pored silicone foams". The conventional term of art, though, would

Art Unit: 1711

be "closed cell", rather than "closed pored". While the claims are not indefinite, it is suggested that the claims are mended to recite a more conventional term.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recited the term "obtainable". The claim is indefinite if undue experimentation is involved to determine boundaries of protection. This rationale is applicable to polymer "obtainable" by a stated process because any variation in any parameter within the scope of the claimed process would change the polymer produced. One who made or used a polymer made by a process other than the process cited in the claim would have to produce a polymer using all possible parameters within the scope of the claim, and then extensively analyze each product to determine if this polymer was obtainable by a process within the scope of the claimed process. See **Ex parte Tanksley**, 26 USPQ 2d 1389.

Claim 8 recited components a) to c) and e), but the claim does not specify what those components are, nor the claim depends on any other claim that defines those components. The claim, in the absence of definition of the claimed components, is too broad and too indefinite to be searched for prior art with any degree of certainty. Claim 8 is, therefore, withdrawn from any further consideration on the merits.

Claim 9 provides for the use of a silicone foam, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 751 173 to Bayer AG (hereinafter "Bayer") published on January 2, 1997 in combination with either US Patent 5,976,454 to Sterzel et al., (hereinafter "Sterzel") or WO 9713804 to Heidelberger Baustofftechnik GMBH, (hereinafter "Heidelberger").

Bayer discloses closed cell foams obtained by reacting a mixture of a) 100 parts by weight of at least one vinyl-containing, linear or branched organopolysiloxane containing at least 2 vinyl groups and having a viscosity of from 0.1 to 1000 Pas, (see

Art Unit: 1711

column 2, lines 15-24), b) from 3 to 200 parts by weight of at least one, optionally surface-modified filler, (see column 2, lines 24-34), c) from 0.5 to 10 parts by weight of hydrosiloxane having at least 3 SiH functions per molecule, (see column 2, lines 35-50), d) from 0.01 to 10 ppm of platinum in the form of a platinum catalyst, (see column 2, lines 52-59), e) from 0.01 to 5 parts by weight of an inhibitor, (see column 3, lines 1-4), and g) from 0.3 to 10 parts by weight of finely divided sodium hydrogen carbonate or ammonium carbonate having a mean particle size of less than 40  $\mu\text{m}$  as blowing agent. The foams are cured at temperatures above the claimed 60 C. See illustrative examples. The difference between the claimed invention and the invention disclosed in the Bayer reference is that the blowing agent claimed in the instant application is finely divided ammonium hydrogen carbonate as compared to disclosed either sodium hydrogen carbonate or ammonium carbonate. Use of the claimed blowing agent, i.e., ammonium hydrogen carbonate in place of expressly disclosed ammonium carbonate would have been obvious in view of, for example, Sterzel or Heidelberger. Both references disclose finely divided ammonium hydrogen carbonate as a known blowing agent for silicone based foams, and also disclose functional equivalence of ammonium hydrogen carbonate and ammonium carbonate. As per, for example, Sterzel, column 9, lines 20-45. Therefore, substitution of expressly disclosed blowing agent with its known functional equivalent would have been obvious absent showing of unexpected results that can be attributed to the specifically claimed blowing agent.

Art Unit: 1711

Alleged unexpected results disclose in the specification are noted. However, the provided results are 1) not commensurate in scope with the claimed invention and 2) the comparative results do not compare the claimed invention with the closest prior art.

As far as the scope of the invention, the claimed invention encompasses embodiments with as little as about 0.1 % and as high as about 10 % of the blowing agent (based on the min and max amounts of components a and b). The alleged unexpected results are only shown for compositions having about 2 % by weight of the claimed blowing agent. As far as the comparison to the closest prior art, the Bayer reference expressly lists TWO different species of the blowing agent, namely sodium hydrogen carbonate and ammonium carbonate. The latter is considered to be the closest prior art to the claimed ammonium hydrogen carbonate.

Therefore, the invention as claimed is considered to have been obvious from the combined teachings of the above cited references and alleged unexpected results fail to rebut the prima facie case of obviousness established by the Examiner as per discussions above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1711

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Irina S. Zemel  
Examiner  
Art Unit 1711

ISZ

A handwritten signature in black ink, appearing to read 'Irina Zemel', with a stylized flourish at the end.